

REMARKS/ARGUMENTS

1. Applicant respectfully requests that the finality of the Office action dated 03 October 2006 be withdrawn and this response be entered as a matter of right on the grounds that the examiner committed errors of law in determining that the declaration was “ineffective” and “insufficient.” (See Section I below)

2. Alternatively, entry of this amendment is respectfully requested on the grounds that it complies with all of the requirements set forth in the final Office action and places the claims in condition for allowance. (See Section II below)

3. Alternatively, entry of this amendment is respectfully requested on the grounds that it focuses the issues for any subsequent appeal. (See Section III below)

I. The finality of the Office action dated 3 October 2006 should be withdrawn.

In the final Office action dated 3 October 2006 the examiner stated that:

4. The declaration is ineffective because an affidavit or declaration under 37 CFR 1.131 may be made by the following:

* * *

(D) The assignee or other part [sic party] of interest when it is not possible to produce the affidavit or declaration of the inventor (**thereby requiring a petition under 37 CFR 1.47**) (emphasis added)

It is respectfully submitted that the emphasized language “thereby requiring a petition under 37 CFR 1.47” does **not** appear in MPEP section 715.04 from which the examiner quoted. Rather, section (D) ends with a citation to *Ex parte Foster*, 1903 C.D. 213, 105 O.G. 261 (Comm’r Pat. 1903). Those authorities authorize the affidavit or declaration to be signed by the assignee.

Section 715.04 of the MPEP goes on to state:

Affidavits or declarations to overcome a rejection of a claim or claims must be made by the inventor or inventors of the subject matter of the rejected claim(s), a party qualified under 37 CFR 1.42, 1.43, or 1.47, **or the assignee or other party in interest**

when it is not possible to produce the affidavit or declaration of the inventor(s). (emphasis added)

The examiner is not free to disregard the MPEP and unilaterally require this applicant to submit a petition under Rule 1.47 when no such requirement is set forth in the MPEP.

Prosecution on the merits should be reopened and this amendment entered as a matter of right.

The Declaration of Russell Slifer filed on 18 July 2006, as well as the Declaration of Russell Slifer filed herewith, are both admissible as they comply with MPEP Section 715.04(I)(D). More specifically, it is a matter of record that Micron Technology, Inc. ("Micron") is the owner by assignment of the present application. The assignment is recorded at Reel No. 012356, Frame No. 0202. Russell Slifer, as set forth in each of his declarations, is Chief Patent Counsel for Micron and the authorized representative of Micron. To ensure that there is no question on this point, filed with this amendment is a resolution from the Board of Directors of Micron indicating that Russell Slifer has the authority to act on Micron's behalf in patent matters. Thus, both of the declarations submitted by Russell Slifer, Chief Patent Counsel for Micron, are admissible, e.g., "effective."

With respect to the Declaration of Russell Slifer submitted 18 July 2006, the examiner stated the following:

7. The 'evidence' cited in the affidavits or declarations has not been clearly explained. While an Applicant may point to figures that correspond with figures in the present specification, it is not an explanation of how those figures show the *claimed* invention. The applicant has not discussed the evidence in the affidavit or declaration with the required detail to be sufficient to establish the conception of the invention prior to the data [sic date] of the Allan et al. reference. (emphasis in original)

Section 715.02 of the MPEP discusses the issue of how much of the claimed invention must be shown. That section of the MPEP states as follows:

The 37 CFR 1.131 affidavit or declaration must establish possession of either the whole invention claimed or something falling within the claim (such as a species of a claimed genus), in the sense that the claim as a whole **reads on it** (emphasis added).

It is respectfully submitted that the examiner has failed to measure the information set forth in the July 18 declaration by the test set out in MPEP Section 715.02.

The declaration first establishes a correspondence between each of the figures of the application and the sheets of figures of the disclosure. That is accomplished in paragraph 4 of the declaration. Paragraph 5 of the declaration sets forth claim 1 in its entirety. Paragraph 6 of the declaration states that “claim 1 reads on, for example, the figure on sheet 1 of Exhibit C [of the July 18 declaration] and figure 1 of the ‘461 application.” Thus, the declaration is in compliance with MPEP Section 715.02.

Because claim 1 reads on both the figure on sheet 1 of Exhibit C of the July 18 declaration and figure 1 of the ‘461 application, that relationship clearly demonstrates that the claimed invention corresponds with, and is fully supported by, sheet 1 of Exhibit C. The other independent claims are dealt with in a similar manner. Thus, it is respectfully submitted that the July 18 declaration of Russell Slifer complies with the requirements of the MPEP and does provide a discussion of the relationship between the invention disclosure materials and the claimed invention.

To eliminate any possibility of confusion on this point, a new Declaration of Russell Slifer is filed herewith. In the new declaration, the language “reads on” has been eliminated in favor of an element matching approach. That is, for each limitation in the claim, examples of elements which support that limitation are identified in the figures of the application. Because the figures in the application are identical to the figures of the disclosure, the necessary relationship between the claimed invention and the disclosure materials is set forth in explicit detail.

In view of the foregoing, it is respectfully submitted that both the July 18 declaration and the new Declaration of Russell Slifer are “effective” as being executed by a party entitled to submit the declaration and that both declarations, taken either individually or together, establish the necessary relationship between the claimed invention and the disclosure materials.

It is respectfully submitted that applicant has demonstrated a conception date earlier than the effective date of Allan et al., and has demonstrated diligence from prior to the effective date of the Allan et al., reference until the filing of the application. It is therefore applicant's position that Allan et al., may not be relied upon by the Office in rejecting the claims of the instant application. As the only rejection of the claims of the instant application is based on Allan et al., it is believed that the instant application is now in condition for allowance.

- II. This amendment should be entered on the grounds that it complies with all of the requirements set forth in the final Office action and places the claims in condition for allowance.

Assuming that the correct legal standard is applied to determine the “effectiveness” of the declarations of Russell Slifer, then the only possible question is the capacity of the Chief Patent Counsel to act on behalf of Micron, the assignee of the entire interest of the instant application. That issue is fully addressed by the enclosed resolution. Accordingly, when the correct legal standard is applied, coupled with the enclosed resolution, the declarations of Russell Slifer are admissible.

Applicant respectfully notes that applicant is proceeding under MPEP section 715.04 (I) (D). Although that section does not indicate that evidence must be presented to establish that it is not possible to produce the affidavit or declaration of the inventor, a Declaration Under Rule 132 is provided by the undersigned explaining why it is not possible to produce the affidavit or declaration of the inventor. The last page of Exhibit B to the undersigned’s Declaration Under Rule 132 contains the inventor’s refusal to execute the Declaration Under Rule 131.

With respect to the second issue, whether the evidence has been clearly explained in a manner that shows the relationship between the disclosure figures and the claimed invention, that issue has been fully discussed in the section above and that discussion need not be repeated here.

In summary, the two defects identified in the final Office action, that the declaration was not signed by a proper party and did not provide an explanation of how the disclosure figures show the claimed invention, have both been rectified by the instant amendment and its enclosures. Thus, the instant amendment complies with all of the requirements of the final Office action.

- III. This amendment should be entered on the grounds that it focuses the issues for any subsequent appeal.

Any appeal in this case should be limited to the sufficiency of the declarations to establish the necessary relationship between the disclosure figures and the claimed invention. The matter of the party competent to sign the declarations is clearly set forth in the MPEP and

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should be clarified at this time so that that issue need not be taken up on appeal. Accordingly, entry of this amendment will focus the issues for appeal.

Paragraph 10 of the specification has been amended to replace "exits" with "exists" to correct an obvious typographical error.

Applicant has made a diligent effort to place the instant application in condition for allowance. The issue fee for this application has already been paid. Accordingly, it is respectfully requested that the instant application be passed to issue so that a patent may be issued for claims 1-38 and 41-44. If the examiner is of the opinion that the instant application is in condition for disposition other than through issuance, the examiner is respectfully requested to contact applicant's attorney at the telephone number listed below.

Respectfully submitted,



Edward L. Pencoske
Reg. No. 29,688
Jones Day
One Mellon Center
500 Grant Street, 31st Floor
Pittsburgh, PA 15219
Telephone: (412) 394-9531
Fax: (412) 394-7959